THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EUGENE A. SARACENO, JR.

_____

Appeal No. 98-1238
Application 08/115,187[1]

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ON BRIEF

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Before COHEN, MEISTER, and FRANKFORT, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Eugene A. Saraceno, Jr. (the appellant) appeals from the final rejection of claims 1-9, the only claims present in the application.

[1] Application for patent filed August 31, 1993.

We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 1, 5, 8 and 9.

The appellant's invention pertains to a wire position support bracket and to a method of using such a bracket. Independent claims 1 and 8 are further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Knell	2,023,083	Dec. 3, 1935
Huehnel	2,867,681	Jan. 6, 1959
Brislin	4,345,381	Aug. 24, 1982
Uhrin et al. (Uhrin)	5,491,902 (filed Aug. 23, 1994)	Feb. 20, 1996[2]

An additional reference of record relied on by this merits panel of the Board is:[3]

Hubbard	4,550,451	Nov. 5, 1985

[2] Although not argued by the appellant, this reference does not appear to qualify as prior art under 35 U.S.C. § 102.

[3] This reference was made of record in the Office action mailed on November 17, 1993 (Paper No. 4).

The claims on appeal stand rejected under 35 U.S.C. § 103 in the following manner:[4]

Claims 1-8 as being unpatentable over Knell in view of Huehnel.

Claim 9 as being unpatentable over Knell in view of Huehnel and either Brislin or Uhrin.

Both of these rejections are bottomed on the examiner's view that it would have been obvious to make the wire positioning support bracket of Knell out of an insulating material in view of the teachings of Huehnel. However, even if we were to agree with the examiner that such a modification of Knell would have been obvious in view of the teachings of Huehnel, we find ourselves in agreement with the appellant's argument on page 9 of the reply brief that the "two-piece" hanger bar or support bracket of Knell cannot be considered to be "an elongated flat planar strip" of material as expressly required by independent claims 1 and 8. Knell's support bracket includes two sections 11, 12 that slidably engage one another in a telescoping manner. Each

[4] On page 3 of the answer the examiner states that the "rejection of claims 1-9 over Dunlap, Simek, Keppler, [and] Hertensteiner as applied in the Final Rejection is withdrawn."

section includes a perpendicularly extending fastening portion or "ledge" 24 and lateral turned-in flanges (13 and 14 in the case of the section 12, and 15 and 16 in the case of section 11).

Consistent with the appellant's specification,[5] we can think of no circumstances under which one of ordinary skill in this art would construe the Knell's two-piece support bracket or hanger to correspond to the claimed "elongated flat planar strip" of material. As the examiner apparently recognizes, there is nothing in the secondary reference to Huehnel, and either Brislin or Uhrin (which have been applied only against claim 9) that would overcome this deficiency of Knell.

In view of the foregoing, the rejections under 35 U.S.C. § 103 of claims 1-8 based on the combined teachings of Knell and Huehnel, and claim 9 based on the combined teachings of Knell, Huehnel and either Brislin or Uhrin are reversed.

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[5] It is well settled that terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them (***In re Bond***, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), ***Specialty Composites v. Cabot Corp.***, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and ***In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)).

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections:

Claims 1 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hubbard. Initially we note that a prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. ***Hazani v. U.S. Int'l Trade Comm'n***, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). If a prior art device inherently possesses the ***capability*** of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. ***In re Schreiber***, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990): "The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."

Here, Hubbard teaches a support bracket for positioning a member that is to be installed between wall support structures comprising an elongated flat planar strip 36 of electrically insulating material (i.e., "plastic" - see column 2, line 9) including mounting surfaces (see Fig. 1) and an array of apertures 48,46 spaced along the length of the strip. Although the strip of Hubbard is illustrated as positioning and supporting pipe, it clearly has the ***capability*** of being used to position and support wire in the claimed manner. After all, the support bracket of Hubbard would not undergo a metamorphosis to a new support bracket simply because it was used to position and support wire, rather than pipe. ***See In re Pearson***, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and ***Ex parte Masham***, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

Claim 8 is rejected under 35 U.S.C. § 103 as being unpatentable over Hubbard in view of Knell. Hubbard teaches the claimed method except that the elongated flat planar strip or support bracket is used to position and support pipe rather than a wire as claimed. Knell, however, teaches an elongated support bracket 10 with spaced apertures 20 that are used to

position and support wires between a pair of wall structures (see Figs. 1 and 2). Applying the test for obviousness[6] as set forth in ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), we are convinced that the combined teachings of Hubbard and Knell would have fairly suggested to one of ordinary skill in this art to modify the method of Hubbard by positioning and supporting wire, rather than pipe.

Claim 9 is rejected under 35 U.S.C. § 103 as being unpatentable over Hubbard in view of Knell as applied in claim 8 above, and further in view of Brislin. Brislin teaches that when wall material is placed on support structures in order to form a completed wall, openings are formed in the wall material in order to accommodate wiring that has been positioned and supported in the interior of the wall. Accordingly, it would further have been obvious to one of ordinary skill in this art when performing the method of Hubbard, as modified by Knell, to complete the wall by (a)

[6] The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

covering the support structures with wall material, (b) forming an opening in the wall where a wire is located, and (c) passing the wire through the opening formed in the wall material as suggested by Brislin.[7]

The appellant argues that Brislin is deficient in that there is no showing therein of forming an opening in the wall material "at the selected aperture" in the support structure. Nevertheless, this reference teaches that the opening in the wall material should be located where the wire has been positioned in the wall. It is the method of Hubbard, as modified by Knell, which provides for the wire to be positioned "at the selected aperture" in support structure. Accordingly, one of ordinary skill in this art following the combined teachings of Hubbard, Knell and Brislin would form the opening in the wall material where the wire has been positioned in the wall (i.e., "at the selected aperture" in support structure).

In summary:

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[7] It should be noted that there is no presumption of any definite sequence of method steps unless the claims are so limited as to require it. ***Ex parte Jackman***, 44 USPQ 171, 173 (Bd. App. 1938).

The examiner's rejections of claims 1-9 under 35 U.S.C. § 103 are reversed.

New rejections of claims 1 and 5 under 35 U.S.C. § 102(b) and of claims 8 and 9 under 35 U.S.C. § 103 have been made.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of
the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

Irwin Charles Cohen Administrative Patent Judge	)	
James M. Meister Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Charles E. Frankfort Administrative Patent Judge	)	

tdc

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